

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. After amending the claims as set forth above, claims 1, 3-5, 9-11, 13, and 15-19 are now pending in this application.

Response to election of species requirement

In response to the election of species requirement set forth in the Office Action mailed on November 25, 2008, Applicants hereby elect the Species of Figure 1, for prosecution in the subject application. Claims 1, 3-5, 9-11, and 13 read on the elected species.

Applicants, of course, reserve the right to file a divisional application covering the non-elected subject matter and/or to receive consideration of claims to additional species as provided by 37 C.F.R. §1.141 and M.P.E.P. §821.04 (rejoinder).

Rejection of claims 10-12 based on 35 U.S.C. 112

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, for various informalities. Claim 10 has been amended to remove the parenthesis. Claim 11 has been amended to change “the cooler” to “a cooler.” Claim 12 has been canceled. In view of these amendments, favorable reconsideration of the rejection is respectfully requested.

Prior art rejections

Claims 1, 5-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,993,367 (“Kehrer”). Claims 1-2 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2003/0015184 (“Klipfel”). Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klipfel in view of U.S. Patent 5,761,902 (“Usami”). Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,702,190 (“Nohl”). These rejections are traversed for at least the following reasons.

Claim 1 (as amended) recites, among other things, a housing; a heat-transfer region comprising heat transfer tubes; a bypass duct; a partition wall arranged between the heat transfer region and the bypass duct; and an actuating element for controlling a flow of exhaust gas through the heat-transfer region and/or the bypass duct. The actuating element comprises a flap and a shaft arranged adjacent to and parallel to the partition wall. The flap is pivotable around the shaft. The housing is integrally formed in a longitudinal direction of the

arrangement for cooling exhaust gas, with the heat transfer region, the bypass duct, the partition wall, and the actuating element being arranged in the housing. Kehrer, Klipfel, Usami, Nohl, or any combination thereof fails to teach or suggest this combination of features.

For instance, none of Kehrer, Klipfel, Usami, and Nohl teaches or suggests that the actuating element comprises a flap and a shaft arranged adjacent to and parallel to a partition wall arranged between the heat transfer region and the bypass duct and that the housing is integrally formed in a longitudinal direction of the arrangement for cooling exhaust gas, with the heat transfer region, the bypass duct, the partition wall, and the actuating element being arranged in the housing. Indeed, none of Kehrer, Klipfel, Usami, and Nohl teaches or suggests the claimed configuration of the partition wall, the flap, and the shaft, along with the other features of claim 1. Because Kehrer, Klipfel, Usami, and Nohl do not teach or suggest all the features of claim 1, claim 1 is allowable over Kehrer, Klipfel, Usami, and Nohl.

Claims 2, 6-8 and 12 have been canceled, which renders the rejection of these claims moot.

Claims 3-5, and 9-11 depend from and contain all the features of claim 1, and are allowable for the same reasons as claim 1, without regard to the further patentable features contained therein.

For at least these reasons, favorable reconsideration of the rejections is respectfully requested.

Allowability of claims 13 and 15-19

Claims 13 and 15-19 depend from and contain all the features of claim 1, and are allowable for the same reasons as claim 1, without regard to the further patentable features contained therein. For at least this reason, allowance of claims 13 and 15-19 is respectfully requested.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 22, 2008 By P.D.S.

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

Paul D. Strain
Attorney for Applicants
Registration No. 47,369